

Group I: Claims 1-9, 16, and 17, drawn to compounds and compositions;

Group II: Claims 10 and 11, drawn to a process of preparing compounds;

Group III: Claims 12 and 13, drawn to polymers with the compounds of Group I;

Group IV: Claim 14 drawn to optoelectronic devices made with the polymers of Group III; and

Group V: Claim 15 drawn to methods of data transmission with the polymers of Group III.

Group II is related to Group I as process of making and product made. Further, Group III is related to Group V as product and process of use. Upon the election and subsequent allowance of the product claims, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be rejoined.

The Examiner also contends that claims 1-8 and 10-17 are generic to patentability distinct species. The Examiner has required the election of a single species for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable. Specifically, the Examiner has required the election of a compound of claim 9 and polymers comprising the same.

Applicants respectfully disagree with the Examiner's restriction of the instant invention and submit that a modification of the restriction requirement is clearly in order for the following reasons.

The MPEP at §808.01(a) states that a "requirement for restriction is permissible if there is a patentable difference between the species as claimed **and** there would be a serious burden on the examiner if restriction is not required" (emphasis added).

Applicants respectfully submit that there would not be a serious search burden on the Examiner if restriction is not required among the compounds of claim 9. Indeed, the MPEP at §808.02 states that:

"the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

- (A) Separate classification...
- (B) A separate status in the art...
- (C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

Here, the claims of Group I are drawn to compounds having a common base structure. As stated hereinabove, a different field of search is shown "where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s)." Here, the search of the prior art pertinent to the formula in claim 1 will clearly result in the finding of art, if any exists, pertinent to the other claims. As such, Applicants respectfully submit that there would not be a serious search burden on the Examiner to search all of the compounds of Group 1.

Further, the compounds recited in claim 9 are members of a Markush group. The MPEP at §803.02 states that:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require

provisional election of a single species.

Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Here, the compounds of claim 1 and the members of the Markush group recited in claim 9 clearly have a common utility (see, e.g., specification in general and claims 12-15). Further, the compounds recited in claim 9 clearly share substantial structural features as evidenced by their sharing a common base structure with the formula provided in claim 1.

For all of the foregoing reasons, Applicants respectfully request withdrawal or, at the very least, modification of the present election of species requirement.

In order to be fully responsive to the instant restriction requirement, Applicants hereby elect, with traverse, Group I, namely, claims 1-9, 16, and 17, drawn to compounds and compositions. With regard to the species election requirement, Applicants hereby elect the compound: [4{2-(*N*-Methylpyridin-4(1*H*)-ylidene)ethenyl}-3-cyano-5,5-dimethyl-2(5*H*)furanylidene}]propanedinitrile. Claims 1-3, 6, 9, and 16 of Group I encompass the elected species.

Applicants hereby reserve the right to file one or more continuing applications, as provided in 35 U.S.C. §120, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully solicited.

Respectfully submitted,
DANN DORFMAN HERRELL and SKILLMAN, P.C.

By Robert C. Netter, Jr.
Robert C. Netter, Jr., Ph.D., J.D.
PTO Registration No. 56,422

Telephone: (215) 563-4100